

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** THOMAS L. RIPLEY, SR.  
and STEPHEN A. CATALDO

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Appeal No. 1999-1781  
Application 08/468,713

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HEARD: JANUARY 27, 2000

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Before ABRAMS, MCQUADE and BAHR, **Administrative Patent Judges.**

ABRAMS, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner  
finally rejecting claims 1-16, which constitute all of the  
claims of record in the application.<sup>1</sup>

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<sup>1</sup> The appellants attempted to cancel claim 16 and replace it with a new claim 17 in an amendment after the final rejection (Paper No. 6). However, the examiner refused to enter the amendment (Paper No. 7) and, although the  
(continued...)

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The appellants' invention is directed to an integrated garden system. The claims on appeal have been reproduced in an appendix to the Brief.

#### ***THE APPLIED REFERENCES***

Ryder	84,002	Nov. 10, 1868
Courtney	1,129,554	Feb. 23, 1915
Aoyama	4,135,330	Jan. 23, 1979
Tomarin	4,396,653	Aug. 2, 1983
Plasticall (European)	0 361 555	Apr. 4, 1990
Kaufmann (Switzerland)	611,117	May 31, 1979

#### ***THE REJECTIONS***

Claim 16 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

The following rejections stand under 35 U.S.C. § 103:

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<sup>1</sup>(...continued)  
appellants have provided arguments in the Brief disputing the examiner's decision, this is a petitionable matter not within the purview of the Board of Patent Appeals and Interferences (see MPEP § 1201 and § 1002.02(c)).

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(1) Claims 1-8 and 13 on the basis of the European reference in view of Ryder.

(2) Claims 9 and 10 on the basis of the European reference in view of Ryder and Courtney.

(3) Claims 11 and 12 on the basis of the European reference in view of Ryder and the Swiss reference.

(4) Claim 14 on the basis of the European reference in view of Ryder and Tomarin.

(5) Claim 15 on the basis of the European reference in view of Ryder and Aoyama.

(6) Claim 16 on the basis of the European reference in view of Tomarin.

Rather than attempt to reiterate the examiner's full commentary with regard to the rejections and the conflicting viewpoints advanced by the examiner and the appellants regarding the rejections, we make reference to the Examiner's Answer (Paper No. 13) and to the Appellants' Briefs (Paper Nos. 10 and 14).

***OPINION***

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellants as set forth in the Answers and the Briefs. As a result of our review, we have determined that none of the rejections should be sustained. Our reasoning in support of this conclusion follows.

***The Rejection Under 35 U.S.C. § 112, Second Paragraph***

The examiner has rejected claim 16 as being indefinite on the basis of the presence of inconsistent language and lack of proper antecedent basis for terms and elements recited in the claim. While the examiner's comments technically are correct, it is our view that the matters raised are not of such magnitude as to preclude one of ordinary skill in the art from understanding the invention defined in the claim, and therefore we will not sustain this rejection. This does not mean, however, that the claim language would not be improved by amendment to eliminate the discrepancies.

***The Rejections Under 35 U.S.C. § 103***

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill

in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a ***prima facie*** case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellants' disclosure. See, for example, ***Uniroyal ,Inc. V. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), ***cert. denied***, 488 U.S. 825 (1988).

The first of the rejections under Section 103 is that independent claim 1 and dependent claims 2-8 and 13 are unpatentable over the European reference in view of Ryder. Claim 1 recites a garden system having a plurality of integratable growing modules, each of which comprises a bottom

plate, side walls, means for attaching modules together and "a fence attached to the top of said side walls and extending outwardly beyond [the] outer periphery surface of said side walls." It is the examiner's position that the European reference discloses all of the subject matter recited in claim 1 except for the fence, but that such a fence is disclosed by Ryder and it would have been obvious to one of ordinary skill in the art to provide the modules of the European patent with a fence "to provide a means for retaining growth medium within the modules" (Answer, page 4). However, in our opinion there is no evidence to support this conclusion.

Ryder discloses planting modules (boxes) which include two pairs of spaced opposing walls, the first pair of which terminates in horizontal upper edges while the second pair terminates in curved upper edges which extend to a height greater than those of the first pair. It is the curved portion of each of the sides of the second pair that the examiner has labeled as "fences." There is no description in Ryder of the sides of the boxes, much less why one pair differs in height from the other. Moreover, since only one pair of sides is taller than the other, and considering the

level at which the potting material is shown in the containers Figures 3 and 4 of the drawings, it is our view that one of ordinary skill would have perceived that the curved upper portions of the second pair of sides merely are ornamental, and are not meant to provide additional means for retaining the potting material, as is urged by the examiner.

It is axiomatic that the mere fact that the prior art structure **could** be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See **In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive in either of the references which would have led one of ordinary skill in the art to modify the module disclosed in the European reference by adding an outwardly extending fence to the top of the side walls, as is required by claim 1.

It therefore follows that the combined teachings of the applied references fail to establish a **prima facie** case of obviousness with regard to the subject matter of claim 1, and

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we will not sustain the rejection of claim 1 or of claims 2-8 and 13, which depend therefrom.

Claims 9 and 10, which also depend from claim 1, stand rejected as being unpatentable over the references cited against claim 1 taken further in view of Courtney, which is cited for its teaching of supplying water to the plants in a growing module. Be that as it may, Courtney does not alleviate the shortcoming discussed above with regard to the application of the teachings of the European reference and Ryder to claim 1. Thus, a ***prima facie*** case of obviousness is lacking with regard to claims 9 and 10, and we will not sustain this rejection.

Likewise, the Swiss reference, which was added to the basic combination of references against dependent claims 11 and 12, Tomarin, added against dependent claim 14, and Aoyama, added with regard to dependent claim 15, fail to cure the defect explained above with regard to the rejection of independent claim 1. This being the case, these rejections also cannot be sustained.

Claim 16 has been rejected as being unpatentable over the European patent in view of Tomarin. As expressed in this



claim, the invention comprises a plurality of growing modules, irrigation means for applying water to the plants therein below the surface of the modules, means for removable attaching the modules together, with "a plurality of said modules having a synthetic surface forming a pathway." The European reference fails to disclose a pathway of any kind. Tomarin discloses a simulated grass playing field, but the examiner has not pointed out where this reference teaches using the product as a pathway. Therefore, it is our view that one of ordinary skill in the art would not have found suggestion in either of the references to modify the modules disclosed in the European reference by providing them with a synthetic surface forming a pathway. The references thus fail to establish a ***prima facie*** case of obviousness with regard to the claimed subject matter, and we will not sustain the rejection.

#### ***SUMMARY***

None of the rejections are sustained.

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The decision of the examiner is reversed.

***REVERSED***

	Neal E. Abrams	)	
	Administrative Patent Judge	)	
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		)	
	John P. McQuade	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	Jennifer Bahr	)	
	Administrative Patent Judge	)	

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